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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/628,427 07/28/00 YANG

T EM/YANG/5860

EXAMINER

MM71/0910

BACON & THOMAS PLLC
4TH FLOOR
625 SLATERS LANE
ALEXANDRIA VA 22314-1176

NGUYEN, T

ART UNIT

PAPER NUMBER

2834

DATE MAILED:

09/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/628,427

Applicant(s)

YANG, TAI-HER

Examiner

Tran N Nguyen

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. **Figures 1-2** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Specification

The abstract of the disclosure is objected to because it is too long. The abstract should be NO more than 1 page or 25 lines. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-17** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-17, the use of grouping words "the said" is indefinite because the double terms "the said" does not clearly set antecedent basis for a referred subject matter. *The applicant is requested to carefully and clearly establish antecedent basis in the claims.*

In claim 1, "wherein its main structure" is indefinite because it is not clear that "its" refers to the electric rotary machine or the cooler device.

In claim 1, "[A] rotational electrical machine which is mainly referred to the rotational machines such as motors or generators, etc." is indefinite because of the use of "etc." does not further set the limitations of the claimed invention.

In claim 1, "[a] fan simultaneously driven by the power output shaft of the rotational electrical machine, or an independently installed fan device or both of them installed simultaneously to pump the air or other selected gases" is indefinite because of the alternative

recitation, particularly the term "other selected gases" does not further set the limitations of the claimed invention. Also "the output shaft" lacks antecedent basis.

In claim 1, "[A] cooler device, whereof it and the rotational electrical machine casing appear individually independent structures and are further combined, or it and the rotational electrical machine appear in an integrated structure, or it and the casing of other peripheral mechanisms with cooling effects (such as the driving device casing or load casing) appear in an integrated structure" is indefinite because of the alternative recitation. Furthermore, the term "appear" merely state the possibility not clearly set the limitations of the claim. Also, the term "other peripheral mechanisms" does not clearly set the specific limitations of the claimed invention.

In claim 1, "[w]hereof the cooler devices are constituted by tubular shape structures or other geometric shape structures, whereof its interior appears in tubular shape or air chamber type structures" is indefinite because of the alternative recitation and the term "appear" which is understood as a possibility instead of clearly setting the limitations for the claim.

In claim 1, "[w]herein the internal air flow circuit or air chamber can be an empty space or can be installed with a air filter device or can be simultaneously installed with an clean cover or a clean plug" does not clearly set the specific limitations of the claimed invention due to alternative recitations.

In claim 2, "[w]hereof it is comprised" is indefinite because it is unclear to what subject matter does the term "it" refers. Is it the electric machine or the cooler device or the enclosed type air cooler device, which includes both the electric machine and the cooler device?

In claim 3, "[t]he piping between the rotational electrical machine and the cooler device is installed with heat absorbing fins which cause the piping forms a bended circuit shape" is indefinite because the term "the piping" lacks antecedent basis. Also, it is unclear what is geometric configuration of a so-called "bended circuit shape". Should it be the heat dissipating fins and the heat absorbing fins interlaced one another?

In claim 4, "[w]herein the rotational electrical machine and the cooler device can be further made in the separated structures" is indefinite because in claim 1 the two subject matters are recited possibly be an integrated structure.

In claim 4, "[a] tubular circuit structure, whereof besides of blended shape, it can be also formed to helical shape or other irregular shapes" is indefinite because of the alternative recitations that do not clearly set the limitations of the claim. In this case it is unclear what is a blended shape or so-called "other irregular shapes"?

The recitations of claims 5-17 contain many issues being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above are, but a few specific examples, of indefinite and functional or operational language used throughout this claim, and are only intended to illustrate the extensive revision required to overcome the rejection under 35 USC 112, second paragraph. The above mentioned corrections therefore, are in no way a complete and thorough listing of every indefinite and functional or operational language used throughout this claim. Applicant is required to revise all of the claim completely, and not just correct the indefinite and functional or operational languages mentioned.

No rejection based on prior art is given at this point of prosecution. MPEP 2173.06 states:

"...where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. As stated in In re Steele , 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under 35 U.S.C. 103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims."

Given the great deal of confusion and uncertainty as to the proper interpretation of the limitations of claims, it would not be proper to reject claims 1-17 on the basis of prior art. Thus, given the 35 USC 112 deficiencies set forth above, no rejection based on the prior art.

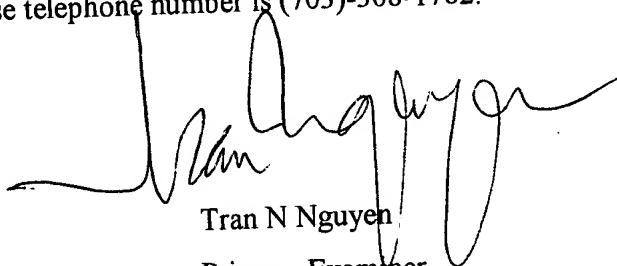
Application/Control Number: 09/628,427
Art Unit: 2834

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran N Nguyen whose telephone number is (703) 308-1639. The examiner can normally be reached on M-F 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703)-308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3431 for regular communications and (703)-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1782.



Tran N Nguyen
Primary Examiner
Art Unit 2834

September 8, 2001